



Paper No. 5

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In re Application of
BROGNE, NICOLAS, *et al.*
Application No. 09/758,245
Filed: 01/12/2001
For: METHOD OF SENDING VOICE
MESSAGES, AND SYSTEM AND SERVER
THEREFOR

OFFICE OF PETITIONS
DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the August 6, 2001 petition Under 37 C.F.R. §1.47(a).

HISTORY

Applicant filed the above-identified application on January 12, 2001, naming Nicolas Brogne, Jean-Pierre Kelles, and Emmanuel Sutter as joint inventors. However, the application as filed did not include the declaration required by 37 C.F.R. §1.53.

Accordingly, on April 4, 2001, the Office of Initial Patent Examination mailed a notice to file missing parts (hereinafter "the notice") to the address of record. A two month extendable deadline was set for filing a reply.

Petitioner filed this reply on August 6, 2001, which with the included two month extension of time request was timely under 37 C.F.R. §§1.7 & 1.8.

LAW

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(l) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

ANALYSIS

Petitioner is urged to note the M.P.E.P. 409.03(d) (Proof of Unavailability or Refusal), which states:

"Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made...[t]he affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not

normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions."

Petitioner has not made a sufficient showing. Specifically, the Commissioner cannot accept that a single mailing to the last known address constitutes a diligent effort to locate co-inventor Sutter. Such an effort constitutes, at best, an unsuccessful first step. A diligent effort should include further steps, such as inquiries made to his current (if known) or former employer, internet searches, and inquiries among known friends and colleagues.

Because of the foregoing, this petition is accordingly *dismissed*.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.47(a)".

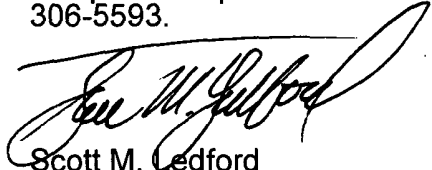
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-5593.



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Office of the Deputy Assistant Commissioner
for Patent Policy and Projects